

BESSETTE, Steven M.  
Appl. No. 10/765,093

Atty. Docket No. : 4380-150

### REMARKS/ARGUMENTS

Claims 1 and 3-14 are pending. Claims 1, 3, 7 and 12 are amended to encompass infringing subject matter. No new matter has been introduced by the above amendments. Applicant does not acquiesce to the propriety of any of the Examiner's rejections and does not disclaim any subject matter to which Applicant is entitled. *Cf. Warner Jenkinson Co. v. Hilton-Davis Chem. Co.*, 41 U.S.P.Q.2d 1865 (U.S. 1997). Further, Applicant reserves the right to file continuing applications to cover disclosed subject matter not encompassed by the currently pending claims.

### DOUBLE PATENTING REJECTION

The Office Action rejects claims 8, 9, 10, and 14 under the judicially created doctrine of double patenting over claims 1-9 of WO00/51436, which has issued as U.S. Patent No. 6,506,707 ("Bessette"). In particular, the Office Action asserts that the present claimed methods, which require applying a composition comprising thymol and clove oil, would have been obvious over the patented claims in Bessette, which merely discloses the application of a composition of thymol and eugenol. Applicant is willing to file a terminal disclaimer to overcome this rejection if it is ultimately deemed proper to do so, Applicant respectfully traverses this rejection.

Applicant respectfully submits that although clove oil contains eugenol, it is not equivalent to eugenol due to other active constituents contained therein. See specification at page 4, paragraph [0024] to page 5, paragraph [0026]. Thus, Applicant respectfully requests reconsideration and withdrawal of this rejection.

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**REJECTION UNDER 35 U.S.C. § 103(a)**

The Office Action maintains the rejection of claims 1-10 under 35 U.S.C. § 103(a), as allegedly being unpatentable over WO00/51436 ("Bessette") and Tworowski (Journal Reference: "Herbicide Effects of Essential Oil," *Weed Science*, 50(4):425-431 (2002)). Applicant respectfully traverses this rejection.

In particular, it is believed that Bessette should be disqualified as prior art against the presently claimed invention because "that subject matter and the claimed invention 'were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.'" See MPEP 706.02(I)(1) (quoting 35 U.S.C. § 103(c)). As previously highlighted, Bessette is a counterpart international patent application that is related to a U.S. patent application that has issued as U.S. Patent No. 6,506,707 (hereinafter "the '707 patent"). The '707 patent, like Bessette, was assigned to EcoSmart Technologies, Inc., of Franklin, Tennessee, as evidenced by an assignment document recorded in the USPTO assignment division at Reel/Frame 010987/0829. Likewise, the above-captioned patent application also has been assigned to EcoSmart Technologies, Inc., of Franklin, Tennessee, as evidenced by an assignment document recorded in the USPTO assignment branch records at Reel/Frame 014317/0370. As such, Applicant respectfully submits that Bessette, its counterpart '707 patent, and the above-captioned patent application were all commonly owned, at the time the presently claimed invention was made, by the same person or subject to an obligation of assignment to the same person. See MPEP 706.02(I)(1) & (2). It is respectfully believed that the rules do not require the above-captioned patent application to claim priority from, or that it is a continuation, continuation-in-part or divisional of, Bessette, as asserted by the Office Action.

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Additionally, the undersigned Attorney of Record proffers the following statement to establish common ownership or assignment under MPEP 706.02(l)(2), part II. In particular, the Attorney of Record hereby states that:

The above-captioned patent application No. 10/765,093, International Patent Application No. WO 00/51436, and U.S. Patent No. 6,506,707 were owned by EcoSmart Technologies, Inc., of Franklin, Tennessee, or subject to an obligation of assignment to EcoSmart Technologies, Inc., at the time the invention of the above-captioned patent application No. 10/765,093 was made.

Moreover, Tworkoski, alone or combined with Bessette, does not disclose or suggest the features of the claimed invention. In particular, Tworkoski does not disclose or suggest herbicidal composition or methods of use wherein the herbicidally active ingredient comprises clove oil and either thymol, thyme oil or methyl salicylate, with or without humic acid or fulvic acid, as presently claimed. Thus, for at least the above reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

### **CONCLUSION**

If anything further could be done to place the above-captioned patent application in better condition for allowance (i.e., via Examiner's Amendment), then please contact the undersigned attorney at the telephone number listed below.

Please grant any extension(s) of time deemed necessary for entry of this communication. The Commissioner is hereby authorized to charge any deficiency in the fee(s) filed, or asserted to

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be filed, or which should have been filed herewith (or with any paper filed hereafter) to Deposit  
Account No. 14-1140. Please credit any overpayment of fees to such Deposit Account.

Respectfully submitted,

NIXON &amp; VANDERHYE P.C.

Date: October 12, 2005By: 

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this document (including any paper referred to as being attached or enclosed) is being sent to the U.S. Patent and Trademark Office via facsimile transmission to (571) 273-8300 on the date indicated below, with a coversheet addressed to Commissioner for Patents, U.S. Patent and Trademark Office.

Date: October 12, 2005By: 

Willem F. Gadiano, Reg. No. 37,136

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